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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,245	03/05/2001	Stephen Charles Salisbury	30275012	7027

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EXAMINER

BUI, KIM T

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/681,245

Applicant(s)

SALISBURY, STEPHEN CHARLES

Examiner

Kim T. Bui

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/05/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are also objected to because there are no references in the figures.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The abstract of the disclosure is objected to because the abstract should be limited to 150 words and should not begin with "Methods to allow". Correction is required. See MPEP § 608.01(b).

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Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Oath/Declaration

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the mailing address of each inventor. A mailing address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing address should include the ZIP Code designation. The mailing address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either on an application data sheet or supplemental oath or declaration.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) As per claim 1, it is unclear if applicant is seeking protection for a method, a software or method of using the software.

(B) As per claim 3, it is unclear if the software is in the computer disk or if the software is writing data onto the disk.

(C) As per claim 6, "other non-protected data subsets" on line 3 is unclear for there is no antecedent basis for any non-protected data subset(s).

(D) As per claim 7, "the imbedded software application " on line 1 and "the application's medical, dental, and pharmacy encounter screens" on lines 3, 4 lack clear antecedent basis.

(E) As per claims 2-7, the language of the claims is unclear, the word "enables" used in these claims is not a descriptive, positively recited language. In addition, it is unclear what are the steps of the recited method.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. The body of the claim(s) must recite how the technological art is employed to produce a useful, concrete and tangible result in a non-trivial manner.

In addition, for a claimed invention to be statutory, it must produce a useful, concrete, and tangible result.

In view of MPEP 2106, for a claimed invention to be statutory, the claims must recite method comprising the steps having practical application in a technological art to produce concrete, useful and tangible result, or computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized.

In the present application, it is unclear if the claims 1-7 recite method having positively recited steps to carry out practical application within a technological art to produce a useful concrete tangible result in a non-trivial manner, or computer

executable code on a computer readable medium. As such, claims 1-7 are rejected under 35USC 101 as non-statutory subject matter.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-5,7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright et al. (US20020046061).

(A) As per claim 1, Wright et al teaches a medical information system comprising software for enabling a patient to record, store, manage (i.e. retrieve), update and share the personal health information with healthcare providers (i.e. pharmacy, hospital, doctors etc...). See Wright et al., page 1, paragraphs 0008, 0009, ,0013, page 3, paragraph 0034. Wright et al. fails to recite a dentist, but suggests that any healthcare center can view the information. Wright et al, page 3, paragraph 0034. It would have been obvious to one having ordinary skill in the art at the time of the invention to include dentists with the motivation of expanding the application of the system.

(B) As per claims 2,3, Wright et al. teaches a re-write enabled, pocket sized, compact computer disk to independently record, store, organize and share health information between patients an providers on page 1, paragraphs 0012-0013, page 2, paragraph 0016.

(C) As per claim 4, Wright et al. teaches the privacy protection by identification on page 3, paragraph 0039.

(D) As per claim 5, Wright et al. teaches the automatically exchange of data between patient and provider practice management and billing systems by the provision of computers, network-connected writer, and communication network (i.e. the Internet). Wright et al. page 3, paragraphs 0031, 0034. page 4, paragraph 0046, Fig. 3. Wright et al. teaches the information may include probable diagnosis (i.e. x-ray images, lab report), medical complaint (i.e., current medical condition). Wright fails to explicitly recite treatment, prescription, date, but suggests on page 1, lines 11-14 of paragraph 0013 that other types of data can be included. It would have been obvious to one having ordinary skill in the art at the time of the invention to include treatment, date, prescription with the motivation of providing details of the patient's medical history for a better evaluation by the current health care provider. Wright, page 1, paragraph 0013, lines 11-14.

(D) As per claim 7, Wright et al. teaches the updating of health histories from data sub-sets associated with medical and pharmaceutical (i.e. drug), and the viewing of the latest health information on a screen. Wright et al, on page 3, paragraphs 0013, 0034, page 4, paragraph 0050, page 5, paragraph 0063. Wright et al fails to recite dental data. It is, dentistry is a common healthcare practitioner. It would have been obvious to one having ordinary skill in the art at the time of the invention to include dental healthcare information with the motivation of expanding the application of the system.

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wright et al. as applied to claim 1 above, and further in view of Ballantype et al. (5867821).

(A) As per claim 6, Wright et al fails to expressly recite a further password protection for data sub-sets. Wright et al, however, suggests on page 5, paragraphs 0063 that various scheme can be used to control the access and the types of data that can be changed. In addition, Ballantype et al. discloses a health information system wherein users (i.e. members) are assigned to specific categories relative to their status and qualification to gain access to portion(s) or subset(s) of data record or information. See Ballantype et al., col. 7, lines 40-43, col. 8, lines 1-28, lines 45-60, col. 9, lines 15-25, col. 9, line 55 to col. 10, line 21, col. 15, line 50 to col. 16, line 15. It would have been obvious to one having ordinary skill in the art at the time of the invention to include level of access to data sub-sets suggested by Ballantype et al in to Wright et al. with the motivation of increasing the security to the system. See Ballantype et al. col. 2, lines 58-63.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. " Patient Monitoring System" (US 2002/0013518 A1), "Portable Personal and Medical Information System" (US 2002/0120470 A1), " Medical Data Recording System" (US 2002/0085476 A1); ""Smart Card Apparatus" (4874935); " Medical Insurance Processing System" (4491725), " Optical Transaction Card System" (6513709 B1), "Computer System For Storing Medical Histories Using a Carrying Size Card" (5659741), "Computer System For Storing Medical Histories Using Smart Card"

(5832488), "Medical Privacy System" (5325294), "ALT (US) launches upgrades for HDI 3000", Clinica 684, p17, Dec. 11, 2005, Dialog File 129, Acc. no. 00470372.

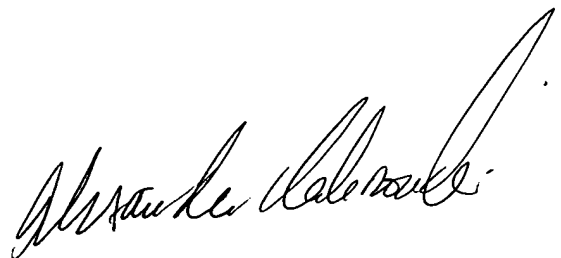
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim T. Bui whose telephone number is 703-305-5874. The examiner can normally be reached on Monday-Friday from 8:30A.M. to 5:00P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


KTB

03/04/2005



ALEXANDER KALINOWSKI
PRIMARY EXAMINER